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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,736	04/30/2001	Masaaki Bannai	389.40083X00	9146

20457 7590 11/10/2003

ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 NORTH SEVENTEENTH STREET
SUITE 1800
ARLINGTON, VA 22209-9889

EXAMINER	
BORISSOV, IGOR N	
ART UNIT	**PAPER NUMBER**
3629	

DATE MAILED: 11/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/843,736	BANNAI ET AL.	
	Examiner	Art Unit	
	Igor Borissov	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *03* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 April 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 8, 16 and 19-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 2, it is not clear what does the term "certain allowable range" actually define.

As per claim 8, the term "the energy service enterprise" lacks anticedent basis.

As per claim 16, it is not clear what method step does the term "assuring under certain conditions" contemplate.

As per claim 19, it is not clear what does the term "important effects" contemplate.

As per claim 20, it is not clear what does the term "ranges" actually define.

As per claim 21, the term "or" renders the claim indefinite. Also, the term "the assured value" lacks anticedent basis.

Claim Rejections - 35 USC § 102

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 8-12 and 16-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Yablonowski et al. (US 6,535,859).

Yablonowski et al. teach a method and system for maintaining lighting systems and for monitoring energy consumption of the lighting sytems, comprising:

As per claim 1,

a database which stores past data about the energy consumption before taking energy-saving measures; measuring means which measures the energy consumption after taking energy-saving measures; and calculating means which calculates the energy curtailment quantities before and after taking energy-saving measures by incorporating measurement data measured by said measuring means via a communication line and comparing said measurement data and the past data stored in said database (column 3, lines 17-19, 49-61; column 4, line 66 – column 5, line 25).

As per claims 5-6, said method and system,

wherein said calculating means calculates the amount of curtailment of the energy costs on the basis of said energy curtailment quantity, and charges an amount obtained by multiplying said amount of curtailment by a predetermined ratio (column 8, lines 30-58).

As per claims 8-9,

installing an energy-saving equipment with the installation cost thereof paid by the energy service enterprise (column 7, lines 4-10); measuring the energy consumption of said object equipment after installation of said energy-saving equipment; determining the difference of the resultant measured value from the energy consumption of said

object equipment before installation of said energy-saving equipment previously stored in the database; calculating the amount of curtailment of the energy costs on the basis of the thus determined difference; and allowing said energy service enterprise to collect said installation cost from said amount of curtailment (column 3, lines 17-19, 49-61; column 4, line 66 – column 5, line 25).

As per claim 16,

drafting energy-saving measures by the energy service enterprise or a related organization thereof; assuring, under certain conditions, a quantity of curtailment of energy consumption available when taking energy-saving measures in accordance with the thus drafted measures (column 6, lines 24-32, 54-56); measuring the energy consumption after taking the energy-saving measures; calculating the amount of curtailment of energy costs by comparing the thus measured value with the energy consumption before taking the energy-saving measures previously stored in a database (column 3, lines 17-19, 49-61; column 4, line 66 – column 5, line 25); and periodically confirming the assured quantity of curtailment (column 8, lines 52-58).

As per claims 2-3, 10 and 17,

storing said energy consumption before taking energy-saving measures in said database, together with the attribute data of variable factors of the energy consumption; measuring the energy consumption after taking said energy-saving measures, together with said attribute data; and comparing said measured value with the energy consumption before taking said energy-saving measures corresponding to said measured attribute data (column 6, lines 24-32, 54-56; column 8, lines 30-59).

As per claims 4, 11 and 18-20, said method and system, wherein said attribute data represents at least one of temperature, humidity and the load quantity of said object equipment (column 6, lines 24-39).

As per claim 12, said method and system, wherein said amount received by the energy service enterprise is determined with reference to the operating hours or the operating rate of said object equipment (column 6, lines 24-34).

As per claims 21 and 22, said method and system, wherein said energy service enterprise receives a compensation in an amount corresponding to the quantity of energy curtailment in excess of the assured value in reward for assuring a quantity of energy curtailment, or as a cost to be appropriated for maintenance or improvement (column 8, lines 30-59).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 7, 13-15 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yablonowski et al.

As per claims 7 and 14-15, Yablonowski et al. teach said method and system, wherein billing for a time period is callculated as a function of the power saving for that particular time period (column 8, lines 40-50).

However, Yablonowski et al. do not specifically teach that if the total amount of the fixed and variable costs is Q, the annual amount of curtailment of energy costs is P, and α and β are positive coefficients (where $\alpha > \beta$), said energy service enterprise receives: X1% of the curtailment amount of energy costs when $P \geq \alpha Q$; X2% of the curtailment amount of energy costs when $\beta Q \leq P < \alpha Q$ (where, X1 < X2); and a predetermined amount when $P < \beta Q$.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yablonowski et al. to include that said energy service enterprise receives: X1%, X2% or a predetermined amount of the curtailment amount of energy costs, because it appears that the claimed features do not distinguish the invention over similar features in the prior art, and the teachings of Yablonowski et al. would perform the invention as claimed by the applicant with funds that said energy service enterprise receives structured in any manner.

As per claims 13 and 23, Yablonowski et al. teach said method and system, wherein, said energy service enterprise performs maintenance or improvement of the equipment subjected to energy-saving measures without compensation (column 8, lines 52-58), after reviewing the feasibility of the project and profit margin (column 6, lines 54-65).

However, Yablonowski et al. do not specifically teach that reviewing the feasibility of the project and profit margin includes establishing a predetermined reference value.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yablonowski et al. to include that reviewing the feasibility

of the project and profit margin includes establishing a predetermined reference value, because it appears that the claimed features do not distinguish the invention over similar features in the prior art, and the teachings of Yablonowski et al. would perform the invention as claimed by the applicant with conducting the feasibility study of the project in any manner.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

IB

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600